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D-1116 RI CIP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Application of |) | |
| Hanna, et al. |) | |
| |) | |
| Application No.: 10/621,433 |) | Art Unit 3693 |
| |) | |
| Confirmation No.: 1731 |) | |
| |) | |
| Filed: July 16, 2003 |) | Patent Examiner |
| |) | Rajesh Khattar |
| Title: Automated Banking |) | |
| Apparatus and Method |) | |

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REQUEST FOR EXPRESS ABANDONMENT OF APPLICATION

This Application is hereby expressly abandoned (37 CFR 1.138). The abandonment of this application does not constitute an admission that the Examiner's position is correct. Applicants continue to respectfully disagree with the rejections. Applicants contend that the claims are patentable. Additional remarks follow.

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The prosecution history shows the Examiner is unreasonable with regard to many issues

Applicants respectfully disagree with the unreasonable positions taken by the Examiner. Applicants respectfully submit that the record clearly shows the Examiner has not established where the applied art teaches or suggests all of the features, relationships, and steps recited in the claims. Further, the Examiner has not identified a *valid* reason for the holding of obviousness, in violation of *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). Thus, Applicants respectfully submit that this application should have been placed in condition for allowance.

Specific examples of the Examiner's unreasonableness**The record is absent evidence that the recited subject matter is taught/suggest in the prior art**

Claim 42 is directed to a *check* having an RFID tag including both first deposit data (e.g., an identifier of a customer banking account to which the deposit is to be credited) and second deposit data (e.g., a financial amount being deposited). At best, the final rejection (at Action page 3) alleges that Fukatsu (US 4,743,743) teaches such a check at col. 4, lines 55-65. Yet this relied upon section makes no mention of "RFID", let alone teach the recited check. No other section in Fukatsu is relied upon for the recited check features. Thus, the rejection is unreasonable.

Furthermore, the record shows that the Examiner's unsupported personal opinion was improperly placed above the knowledge of the person of ordinary skill in the art. The unsupported assertion in the claim 42 rejection that it would have been obvious to have modified Fukatsu for reasons of "aesthetic design change" is also unreasonable. The present application is *not* a design application.

The Examiner admits that the recited subject matter is not taught/suggest in the applied art

The Action (e.g., at page 4) admits that the solely relied upon Fukatsu reference is devoid of all of the recited features and relationships. Applicants respectfully submit that in light of the admitted failure of the solely applied reference to teach or suggest all of the recited features and relationships, combined with the lack of any other supporting evidence of record, the rejections cannot be legally valid. The record *prima facie* lacks evidential support for the rejection. This issue is well settled. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Thus, the Examiner is unreasonable by not allowing the application.

The double patenting allegation

The allegation of double patenting is based solely on having claims "directed towards depositing a financial instrument into an ATM" (Action page 11). However, using such a broad brush to allege double patenting is legally improper. There would appear to be hundreds of valid patents (and likely an entire U.S. classification subclass) that would meet such a broad definition. Thus, the rejection is unreasonable.

The prosecution history suggests that the Examiner will continue to be unreasonable

Applicants respectfully decline to continue participation in a prosecution which follows a pattern of Examiner unreasonableness, especially when the unreasonableness is directly contrary to the facts of record. The Applicants' desire for compact prosecution prevents participation related to such actions.

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The Examiner's unreasonableness, which unfortunately has become predictable, also indicates to Applicants that no amendment (or BPAI reversal) would appease the Examiner to soon allow the application. Again, Applicants decline to further take part in the Examiner's acts of unreasonableness even though his positions with regard to the rejections are legally improper.

The Applicants reserve all rights to have the recited subject matter refiled

Applicants do not waive any right to obtain similar claim coverage through a different US application. That is, Applicants reserve all rights to have the recited subject matter considered by another Examiner, including a Primary Examiner in a different art unit or Technology Center.

Conclusion

The Office would be in clear error if it expects any Applicant to continue participation in an examination which includes a continuing pattern of Examiner unreasonableness.

Respectfully submitted,



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